

REMARKS

Claims 1-15 and 17-27 were previously pending, of which claims 1, 3-5, 7, 18, and 24 have been amended, and of which claims 2, 6, 11-15, 17, 20-23, 25-27 have been canceled. New claims 28-36 have been added. Reconsideration of presently pending claims 1, 3-5, 7-10, 18-19, 24, and 28-36 is respectfully requested in light of the above amendments and the following remarks.

Rejections under 35 U.S.C. § 112, second paragraph

Claim 23 was rejected. Claim 23 has been canceled.

Rejections under 35 U.S.C. § 102 (first interpretation and second interpretation)

Claims 1-15, 17-20, and 22-27 were rejected under 35 U.S.C. §102(b) as being anticipated by Ouchi (US Patent No. 6,206,904 B1) under a first interpretation. Claims 1 and 21 were rejected under 35 U.S.C. §102(b) as being anticipated by Ouchi under a second interpretation. As set forth at MPEP §2131, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” With respect to the claims as herein amended, this rejection is respectfully traversed.

Amended claim 1 now requires:

A surgical instrument for extracting a prosthetic device, comprising:

a distal portion transitional from an insertion configuration to an extraction configuration, wherein the insertion configuration is adapted for displacement along a portion of a prosthetic device, and the extraction configuration is adapted for engaging and extracting the prosthetic device, the distal portion having a natural bias towards the extraction configuration, the distal portion including a first extraction prong and a second extraction prong, the first extraction prong extending distally from a first location and the second extraction

prong extending distally from a second location, the first and second locations being laterally spaced apart from each other; and
a proximal portion connected to the distal portion.

Ouchi teaches that “[a] plurality of foreign body-catching arms 5 are bundled together at the proximal ends and inserted into a connecting pipe 9 and secured therein.” (Col. 4, lines 43-45 and Figs. 5-9, 13-14). In Fig. 5, four foreign body-catching arms are arranged in a circular pattern extending from the connection at 90 degree intervals. (Col. 4, lines 30-32 and Fig. 5). Each arm is secured to the same location, vis-a-vis insertion into the connecting pipe. (Col. 4, lines 43-45 and Fig. 5). Thus, Ouchi teaches foreign body-catching arms extending from a *single* location. Since the required elements of claim 1 are absent, the rejection is not supported by the Ouchi reference and should be withdrawn.

For reasons similar to those set forth above with respect to claim 1, the method of amended independent 18 is not anticipated by the Ouchi reference. Still further, the Ouchi reference fails to disclose the method of claim 18 requiring:

positioning a first extraction prong adjacent a first lateral portion of an implant and positioning the second extraction prong adjacent an opposing second lateral portion of the implant;
inserting the first and second extraction prongs into the implant in the insertion configuration; [and]
transitioning the distal portion to the extraction configuration;

Ouchi discloses maintaining the arms side by side and closely adjacent in the insertion configuration during the step of insertion to prevent injury to the patient, rather than laterally spaced as now set forth in claim 18. For at least this reason, the rejection of claim 18 should be withdrawn.

Dependent claims 3-5, 7-10, 19 and 24, depend from, and further limit, independent claims 1 and 18, respectively, and therefore should be allowable as well.

New claims 28-36 have been added to more clearly define the claimed invention. It is believed that for at least the reasons set forth above with respect to claim 1, new claim 28 distinguishes over the Ouchi reference. Dependent claims 29-36 further limit independent claim 28. Since the elements set forth in these claims are not found in the cited references, claims 28-36 should be allowable.

US Ser. No.: 10/665,578
Amendment to Office Action of March 2, 2007

Attorney Docket No.: Docket No.: PC764.00 / 31132.159
Customer No.: Customer No.: 46333

Conclusion

Reconsideration of presently pending claims 1, 3-5, 7-10, 18-19, 24, and 28-36 is hereby respectfully requested. A notice of allowance is hereby respectfully requested. Should there remain any questions, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

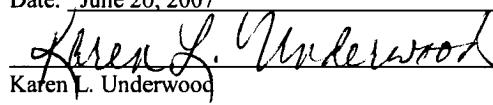


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I hereby certify that this correspondence is being filed with the United States Patent and Trademark Office via EFS-Web on the following date.

Date: June 20, 2007


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